

138/362/B

TRANSMITTAL OF APPEAL BRIEF

Docket No.
65678-0037

In re Application of: J. A. Bly et al.

Application No. 09/714,702-Conf. #5353	Filing Date November 16, 2000	Examiner C. L. Hewitt	Group Art Unit 3621
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Invention: APPARATUS AND METHOD FOR TRACKING AND MANAGING PHYSICAL ASSETS

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: May 4, 2004

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Dated: July 1, 2004

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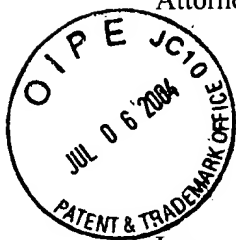
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Serial No. 09/714,702
Attorney Docket No. 65678-0037



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: BLY, et al.

Serial No.: 09/714,702

Group Art Unit: 3621

Filed: 11/16/2000

Examiner: HEWITT II, Calvin L.

For: APPARATUS AND METHOD FOR TRACKING AND MANAGING
PHYSICAL ASSETS

Attorney Docket No.: 65678-0037

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BRIEF ON APPEAL

Honorable Sir:

This Appeal is taken from the Examiner's Final Rejection dated February 6, 2004 (hereinafter the "Final Office Action") of claims 1-25 in the above-identified application. The Notice of Appeal was timely filed on May 4, 2004. Submitted herewith are two additional copies of this Appeal Brief. Applicants (hereinafter "Appellants") respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application referenced above.

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I. REAL PARTY IN INTEREST

The Real "Party-In-Interest" is Dana Corporation, located at 4500 Dorr Street, P.O. Box 1000, Toledo, Ohio 43697. Dana Corporation was assigned all rights to the U.S. Patent Application identified by Serial No. 09/714,702 on May 15, 2003 by Dana Commercial Credit Corporation of 660 Beaver Creek Circle, Maumee, Ohio 43537.

II. RELATED APPEALS AND INTERFERENCES

On July 9, 2003, Appellant filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/441,289 filed November 16, 1999. The application at issue in this appeal is a C-I-P application claiming priority from application 09/441,289.

On July 9, 2003, Appellant filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,000, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/504,000.

On October 9, 2003, Appellant filed a notice of appeal, and on December 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,343, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/504,343.

On October 24, 2003, Appellant filed a notice to appeal the final rejection of U.S. Application Serial Number 09/503,671, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. On November 25, 2003, after Appellant had filed the afore-mentioned notice of appeal, the Office mailed a new final rejection of all claims. In response, Appellant submitted an Amendment Pursuant to 37 C.F.R. §1.116 and a Notice of Appeal, both dated January 20, 2004. An Advisory Action was mailed on February 2, 2004. Appellant subsequently filed an Appeal Brief on April 20, 2004. The application at issue in this appeal is a C-I-P application claiming priority from application 09/503,671.

On December 12, 2003, Appellant filed a notice to appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial Number 09/653,735, filed September 1, 2000 as a C-I-P application claiming priority from the following applications: U.S. Application Serial No. 09/441,289 filed November 16, 1999; U.S. Provisional Application Serial No. 60/166,042 filed November 17, 1999; U.S. Application Serial No. 09/503,671 filed February 14, 2000; U.S. Application Serial No. 09/504,000 filed February 14, 2000; and U.S. Application Serial No. 09/504,343 filed February 14, 2000.

III. STATUS OF CLAIMS

Claims 1-25 are pending. In the Final Office Action: (1) claims 1-4, 8-11, 16-18, and 21-14 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,875,430 ("Koether"); (2) claims 5-7 and 25 were rejected under 35 U.S.C. 103(a) as being obvious over Koether; and (3) claims 12-15, 19, and 20 were rejected under 35 U.S.C. 103(a) as being obvious over Koether in view of U.S. Patent No. 5,900,801 ("Heagle") and U.S. Patent No. 6,417,760 ("Mabuchi").

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection. A copy of all claims on appeal is attached hereto as an Appendix.

V. SUMMARY OF THE INVENTION

A computer based system automatically gathers, analyzes, and delivers information relating to the procurement and utilization of a plurality of assets, such as a fleet of industrial equipment. The system thereby maximizes productivity by reducing operating costs and administrative burdens. Each of the assets is preferably provided with a data acquisition device for sensing and storing one or more operating characteristics associated therewith, such as a fault code generated by the asset when there is a maintenance problem or when routine maintenance is required in accordance with predetermined criteria. Information comprising an asset's operating characteristics can be transmitted through space to a receiver connected to a local controller for

storing such information and for transmitting such information over the Internet to a remote analysis system. (Specification, page 4, lines 1-12.)

The remote analysis system automatically updates individual records associated with each of the assets with the information received from the Internet. In response to such information, the remote analysis system automatically analyzes the newly provided information and generates reports regarding scheduled maintenance, warranty coverage, and other management information. These reports can be transmitted back over the Internet to an administrative controller for review by one or more persons responsible for managerial review. Additionally or alternatively, the remote analysis system can automatically post such reports on a website and, thus, reports can be made available to one or more of such persons upon request. (Specification, page 4, lines 12-20.)

Not only can the information be provided to an administrative controller, but also it can be provided to third parties such as maintenance organizations, asset manufacturers or suppliers, and leasing companies. By providing up-to-date real-time and historical information concerning the asset, such third parties are willing to share the risk of the asset's usage, maintenance, and performance through creative arrangements with the asset user. A maintenance organization, for example, may be willing to enter into a fixed maintenance contract when it has the ability to readily detect adverse maintenance trends regarding an asset and is given the ability to take pro-active steps to address problems before they become major. The cost-savings associated with such a pro-active approach by an expert may be shared to the benefit of the business and the maintenance organization. Similarly, a leasing company that can reduce ownership risk through asset monitoring and appropriate asset utilization is more likely to agree to a hybrid minimum term payment and asset usage billing system or even a usage based billing system with no minimum payments. (Specification, page 4, line 21 – page 5, line 2.)

VI. ISSUES PRESENTED

- A. Whether Koether anticipates claims 1-4, 8-11, 16-18, and 21-24 under 35 U.S.C. § 102 (e).
- B. Whether claims 5-7 and 25 are obvious over Koether under 35 U.S.C. § 103(a).

C. Whether claims 12-15, 19, and 20 are obvious over Koether in view of Heagle and Mabuchi under 35 U.S.C. § 103(a).

VII. GROUPING OF CLAIMS

The claims do not stand or fall together.

Claims 1, 8, 18, and 21-25 stand or fall together as Claim Group A.

Claim 2 stands or falls alone as Claim Group B.

Claim 3 stands or falls alone as Claim Group C.

Claim 4 stands or falls alone as Claim Group D.

Claim 9 stands or falls alone as Claim Group E.

Claim 10 stands or falls alone as Claim Group F.

Claim 11 stands or falls alone as Claim Group G.

Claim 16 stands or falls alone as Claim Group H.

Claim 17 stands or falls alone as Claim Group I.

Claims 5 and 6 stand or fall together as Claim Group J.

Claim 7 stands or falls alone as Claim Group K.

Claims 12 and 20 stand or fall together as Claim Group L.

Claims 13 and 14 stand or fall together as Claim Group M.

Claim 15 stands or falls alone as Claim Group N.

Claim 19 stands or falls alone as Claim Group O.

Reasons for separate patentability of the above-indicated Claim Groups A, B, C, D, E, F, G, H, I, J, K, L, M, N, and O are presented in the Arguments section pursuant to 37 C.F.R. § 1.192(c)(5).

VIII. ARGUMENTS

A. INTRODUCTION

All Claim Groups are in condition for allowance for at least two distinct reasons. First, as detailed below with respect to each claim group, the Examiner has either failed to state a *prima facie* case of anticipation or to establish a *prima facie* case of obviousness because he has not specifically addressed each recited claim limitation, and the prior art of record does not teach or

suggest each recited claim limitation. Glaringly, the Examiner has failed to respond to all of the arguments and the requests for support that were presented by Appellant in Remarks filed August 11, 2003 and January 20, 2004. For example, as detailed below, the Examiner has not provided support for the taking of Official Notice even though the Appellant seasonably requested that such support be provided pursuant to 37 CFR 1.104(d)(2) and MPEP 2144.04. Second, as is also detailed below, the Examiner has failed to establish a *prima facie* case of obviousness with respect to certain claims by failing to provide a motivation to modify or combine the cited art.

A valid claim rejection requires, among other things, that the applied references teach or suggest all of the claim limitations. *See* MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981, 180 USPQ 560, 562 (CCPA 1972). Appellant respectfully submits that the Final Office Action merely generally address some of the elements included in Appellant's claims as is detailed below. Consequently, the references do not teach every element of the claims, and the rejections do not satisfy the standard set forth by the Federal Circuit in *In re Thrift*, Case Number 01-1445 (Fed. Cir. August 9, 2002), which prohibits the rejections of claims based on a "very general and broad conclusion" when "cited references do not support each limitation" in a claim. Moreover, as the Federal Circuit decision in *In re Sang Su Lee*, 2002 U.S. App. LEXIS 855 (Fed. Cir. January 18, 2002) makes clear, each and every element of Appellant's claims must be supported by a prior art citation in order to reject Appellant's claims.

The Final Office Action fails to separately identify each claim and its limitations, and fails to state how the prior art of record applies to each limitation of each claim. For example, pages 4-6 of the Final Office Action provide a list of disclosures by Koether without identifying the claim or claim limitations on which the Examiner believes each of these disclosures reads. The listed disclosures do not all match limitations in the Appellant's claims. The Examiner has therefore left it to the Appellant to guess which claim limitation is being rejected by any given listing of a disclosure by Koether. By failing to specifically identify the claim limitations on which the Examiner believes the cited art disclosures reads, the Examiner has failed to state a valid claim rejection.

Further, it appears that the Examiner intended many of the stated disclosures from Koether to be combined with other references, or with the taking of Official Notice. However, it is impossible for Appellant to determine what the Office believes to be the basis for an obviousness rejection of each claim because the Final Office Action fails to identify specific claims, much less specific claim limitations, to which the prior art of record is being applied. In short, the Final Office Action fails to cite support in the prior art for every claim limitation in the Appellant's claims. Therefore, the Final Office Action fails to establish a *prima facie* case of obviousness against such claim limitations.

All Claim Groups are in condition for allowance at least because (1) the Final Office Action does not adequately identify citations in the art that would render each and every claim limitation obvious, (2) the cited art does not disclose all of the claim limitations of at least Appellants' independent claims, and (3) the modification and combination of the cited references asserted by the Examiner would not have been obvious to one of ordinary skill in the art at the time of invention because there was no motivation to modify or combine them. Thus, the Examiner has either failed to state a *prima facie* case of anticipation or to establish a *prima facie* case of obviousness against each of the Claim Groups.

B. KOETHER FAILS TO ANTICIPATE CLAIMS 1-4, 8-11, 16-18, AND 21-24.

1. Claims 1, 16, and 18: Koether does not disclose generating “a preventative maintenance determination”.

Independent claims 1, 16, and 18 were rejected under 35 U.S.C. 102(e) as being anticipated by Koether. Claims 1, 16, and 18 recite generating “a preventative maintenance determination from said acquired data and at least one historical characteristic relating to said asset.” None of the references cited in the Office Action anticipates or even suggests such a limitation. Similarly, none of the cited references nor any combination thereof, would render the claimed functionality obvious to one of ordinary skill in the art.

The phrase “maintenance history” appears only once (col. 11, line 41) within the Koether disclosure, wherein Koether discloses that service technicians may request maintenance history information from a service center while performing a repair. Koether fails to disclose or suggest any use of maintenance history information in the determination of whether to perform maintenance. Koether certainly does not teach or suggest “an analysis controller . . . that is responsive to . . . acquired data” and that incorporates both acquired data and historical data into

maintenance decisions. Further, Koether actually teaches against generating a preventative maintenance determination in two ways: (1) Koether teaches an analysis of diagnostic information that would be unnecessary if a preventative maintenance determination were generated; and (2) Koether teaches scheduled maintenances that would be redundant if preventative maintenance determinations were used.

Koether teaches a “control center” that “analyzes . . . diagnostic information” (Koether, col. 9, lines 44-45), but contains absolutely no teaching or suggestion of “generating a preventative maintenance determination”. In Koether, maintenance history is merely stored, providing human beings with the ability to access the information at a later time. (*E.g.*, Koether, col. 11, lines 36-46.) Appellants’ claims, in contrast, recite that acquired data and historical data are used in a dynamic fashion to schedule future maintenance. Koether teaches against this claim limitation because Koether teaches analyzing the diagnostic information to determine “whether to disable the appliance . . . or . . . to modify the cooking profiles stored in the appliance.” (Koether, col. 9, lines 45-48.) That is, Koether teaches taking steps that would be unnecessary if a preventative maintenance determination had been generated.

Koether also teaches scheduled maintenances that would have left one of ordinary skill with no reason to generate a preventative maintenance determination. In the Final Office Action, the Examiner argues that Koether teaches “generating a preventative maintenance determination” by disclosing that

Normally, monitoring and tracking control passes to the control center after a malfunction or fault has been reported by the microprocessor based controller. However, the control center may effect preventive maintenance even when there is no malfunction reported. *Scheduled preventive maintenances* are stored in database 190. Alternatively, each base station may request preventive maintenance for its associated kitchen appliance(s). At the appropriate time, control center 170 dispatches a service vehicle. (Koether, col. 8, lines 30-39; emphasis added.)

This portion of Koether cited by the Examiner demonstrates how Koether teaches away from Appellants’ claimed invention by disclosing *scheduled* preventative maintenances, thus leaving no need to *generate* a preventative maintenance determination.

Accordingly, Koether not only fails to disclose generating a preventative maintenance determination, but, for at least two independent reasons, is incapable of even suggesting such a

limitation. Therefore, for the foregoing reasons, claims 1, 16, 18, and all of their dependent claims (claims 2-15, 17, 19-25) are in condition for allowance.

2. Claim 2: Koether does not disclose a hand held device that is in direct contact with an analysis controller.

Koether does not teach or suggest that “said hand held device is in direct contact with said analysis controller” as required by claim 2. Figure 8 of Koether shows that the portable hand held terminal (810) communicates with a control center (170) *indirectly* through a kitchen base station (150) and a data network (180). Moreover, Koether clearly states that the portable hand held terminal communicates to the control center via a kitchen base station (Koether, col. 10, lines 23-25). Clearly, Koether discloses indirect contact rather than direct contact between a portable hand held terminal and its control center.

In fact, Koether’s teaching of a hand held device in *indirect* contact with the control center could not possibly anticipate a hand held device in *direct* contact with the analysis controller of the claimed invention. In the Final Office Action (page 4), the Examiner asserts that Koether’s control center anticipates “an analysis controller located at a second location that is responsive to said acquired data from said local controller for generation an analysis of said acquired data” (claim 1). Indeed, Koether’s control center is the only item taught by Koether that could possibly be said to anticipate the analysis controller of the claimed invention. No other element disclosed in Koether performs any analysis of data (*see* Koether, col. 9, lines 44-48).

Although Koether teaches that a “kitchen base station may contain internally resident databases necessary or useful in the customer billing or accounting process” (Koether, col. 5, lines 52-55), nowhere in Koether is disclosure made of a kitchen base station performing any analysis. Koether discloses that the kitchen base stations merely store data in databases and relay communications between the control center and appliance controllers (Koether, Figure 8; col. 5, lines 52-55). Besides not performing any analysis, the kitchen base stations of Koether are located at the restaurant where the appliance controllers are located. (Koether, Figure 8.) Only Koether’s control center could possibly anticipate an analysis controller as claimed, and the control center and portable hand held device communication only indirectly. Thus, Koether clearly does not anticipate a hand held device “in direct contact with said analysis controller” as required by claim 2.

Therefore, for at least the foregoing reasons, claim 2 is in condition for allowance.

3. Claim 3: Koether does not disclose a second computer system disposed between said analysis controller and said hand held device.

The Office Action does not point to any portion of Koether that allegedly anticipates a second computer system “disposed between said analysis controller and said hand held device” as recited in claim 3. As discussed above, the Examiner asserts on page 4 of the Final Office Action that Koether’s control center anticipates the analysis controller of the claimed invention. The Examiner also asserts that Koether’s portable hand held terminal anticipates the claimed hand held device (Final Office Action, page 5). However, the Final Office Action fails to point to any portion of Koether that anticipates a second computer system “disposed between said analysis controller and said hand held device”.

The Examiner does assert that Koether’s control center anticipates a second computer system that “receives said acquired data, selectively modifies aspects of said acquired data, and forwards said acquired data including said modified aspects, to said hand held device” as recited in claim 4. (Final Office Action, page 5.) By this assertion (which, as discussed below, is incorrect), the Examiner takes contradictory and mutually exclusive positions regarding Koether’s control center. Koether, as discussed above regarding claim 2, describes the control center, rather than a second computer system, “disposed between said analysis controller and said hand held device” (claim 3, emphasis added). Koether’s control center cannot anticipate both the claimed invention’s analysis controller (as discussed above) as well as the second computer system “disposed between said analysis controller and said hand held controller” (claim 3). The analysis controller and the second computer system are distinct elements of the claimed invention. Thus, not only does Koether fail to read on either claims 3 or 4, but it is logically impossible that Koether reads on both claims 3 and 4.

Therefore, Koether fails to anticipate each element of claim 3, which for at least this reason is in condition for allowance, as is claim 4, depending from claim 3.

4. Claim 4: Koether does not disclose a second computer system that receives said acquired data, selectively modifies aspects of said acquired data, and forwards said acquired data including said modified aspects to said hand held device.

Claim 4 recites that “said second computer system receives said acquired data, selectively modifies aspects of said acquired data, and forwards said acquired data including said modified

aspects, to said hand held device.” As discussed above, Koether’s control center cannot anticipate both the claimed analysis controller (claim 1) and the claimed second computer system “disposed between said analysis controller and said hand held device” (claim 3). If the “second computer system” of claims 3 and 4 is disclosed in Figure 8 of Koether as asserted by the Examiner, then the Examiner asserts that the “kitchen base station” (150) or the “data network” (180) is the “second computer system” of claims 3 and 4. No other association in Koether appears even remotely similar to the relationship between the analysis controller, the second computer system, and the hand held device of claims 3 and 4. However, neither the kitchen base station nor the data network in Koether anticipate each and every element of the second computer system as claimed.

There is no evidence in Koether that either the kitchen base station or the data network “selectively modifies aspects of said acquired data, and forwards said acquired data including said modified aspects, to said hand held device” (claim 4, emphasis added). Koether discloses that kitchen base stations contain data (Koether, col. 5, lines 52-55) and transmit communications between a control center and appliance controllers or hand held terminals (Koether, Figure 5; col. 5, lines 36-38; col. 6, lines 61-65; col. 10, lines 22-25). Similarly, Koether discloses that the data network provides communications between the kitchen base stations and the control center (Koether, col. 5, lines 36-38). Nowhere does Koether disclose that either the kitchen base station or the data network “selectively modifies aspects of said acquired data, and forwards said acquired data including said modified aspects, to said hand held device” (claim 4, emphasis added). For at least this second independent reason, claim 4 is in condition for allowance.

In Remarks filed on August 11, 2003 (page 14), Appellants stated that “if the Examiner disagrees with the distinctions presented above, [Appellants] respectfully request that the Examiner specifically attempt to link each of the devices in Koether (including element numbers) to the Applicants’ specific claim elements in order to more clearly and specifically set forth the functionality provided by the various components.” The Examiner did not respond to this request. Moreover, it is clear that Koether does not teach at least the specific claim limitations discussed above.

For at least the foregoing reasons, claim 4 is in condition for allowance.

5. Claims 9 and 17: Koether fails to disclose either best practice level or past historical data to provide for comparison with collected data.

Contrary to the Examiner's assertion, Koether does not disclose a database that includes best practice level or past historical data "to provide a base point for comparison with said collected data" as recited in claims 9 and 17. Although Koether does discuss use of a database, Koether does not disclose a database that contains data "to provide a base point for comparison with said collected data" (claims 9 and 17, emphasis added). Koether does not discuss comparing comparison data with collected data. The only comparison functionality mentioned in Koether is a comparison of a calculated load value to a maximum load value (Koether, col. 12, lines 44-46). Comparison of a calculated load value does not anticipate comparison of best practice level or historical data with collected data.

Moreover, while Koether does disclose historical data in its database, Koether does not disclose using "past historical data to provide a base point for comparison with said collected data" (claims 9 and 17, emphasis added). This comparison is simply not within Koether's disclosure of a calculation-based comparison. As discussed above, Koether does not disclose using past historical data for comparison with collected data. Moreover, Koether fails to disclose any functionality relating a best practice level.

Therefore, for at least the foregoing reasons, claims 9 and 17 are in condition for allowance.

6. Claim 10: Koether fails to disclose user data representing a user accessing an asset.

Koether fails to disclose "user data representing a user accessing the asset" as recited in claim 10. Any disclosure in Koether regarding user data or access information is limited to billing functionality (*e.g.*, Koether, col. 10, lines 45-51) and is not related to a user accessing an asset. Other references to identification data in Koether refer to appliance identification rather than identification of a user accessing an asset (col. 10, lines 30-44).

Therefore, for at least the foregoing reasons, claim 10 is in condition for allowance.

7. Claim 11: Koether fails to disclose user data that "includes at least a subset of user identification, and access authorization".

There is no mention in Koether of user data that "includes at least a subset of user identification, and access authorization" as recited in claim 11. As explained in the previous section, Koether's disclosure of using a personal identification number is limited to billing

functionality and does not relate at all to “access authorization” (claim 11) for “a user accessing the asset” (claim 10).

Therefore, for at least the foregoing reasons, claim 11 is in condition for allowance.

8. Claims 16 and 17: Koether fails to disclose “a hand held device including a form, said form providing at least a subset of said data values for the entry of foundational data, said foundational data being transmitted to said analysis controller and stored in said database.”

Although the Examiner rejected claims 16 and 17 under Section 102(e), the Office Action fails to point to any part of Koether that anticipates “a hand held device including a form, said form providing at least a subset of said data values for the entry of foundational data, said foundational data being transmitted to said analysis controller and stored in said database” as recited in claim 16. Moreover, the Final Office Action admits on page 7 (in its discussion of Section 103(a) rejections) that Koether does not anticipate this limitation of claim 16.

The citation to Koether provided in the Final Office Action (page 7) refers only to maintenance and repair activities (Koether, col. 11, lines 15-29). There, Koether discloses that a user of a portable hand held terminal can send a request to the control center for a transmission to the terminal of diagnostic software or maintenance instructions for the relevant appliance (col. 11, lines 15-29). This disclosure is limited to functionality for making a request from a hand held terminal for a transmission of repair and maintenance instructions to the hand held terminal. Repair and maintenance instructions are clearly not “foundational data” (claim 16) as claimed. Indeed, Appellants’ Specification clearly explains that “foundational data” is data about various attributes of an asset, not instructions for repairing or maintaining the asset. (Specification, page 34, line 13, page 35, line 19.)

Further, Koether makes no disclosure of a form providing at least a subset of said data values for the entry of foundational data” or of “foundational data being transmitted to said analysis controller and stored in said database” (claim 16). The only hint of any sort of form in Koether is related to billing records and invoices (Koether, col. 10, line 62 – col. 11, line 8). Thus, Koether at most teaches billing records that are unrelated to a “form providing at least a subset of said data values for the entry of foundational data” as required by claim 16.

Therefore, for at least the foregoing reasons, claim 16 and its dependent claim 17 are not anticipated by Koether and are in condition for allowance.

C. CLAIMS 5-7 ARE NOT OBVIOUS OVER KOETHER.

In the Office Action, claims 5-7 were rejected under 35 U.S.C. 103(a) as being obvious over Koether.

1. Claims 5 and 6: “Forms providing data values for the entry of foundational data associated with said data values” would not have been obvious to one skilled in the art.

As discussed above regarding claims 16 and 17, and as the Examiner concedes (Final Office Action, page 7), Koether does not teach or suggest “forms providing data values for the entry of foundational data associated with said data values, said data values and said foundational data being transmitted to said analysis controller” as required by claim 5. The Examiner admits that Koether doesn’t explicitly recite foundational data being collected prior to acquired data as claimed in claim 6 (Final Office Action, page 7). The Examiner further admits that Koether does not explicitly recite forms used to collect foundational data (Final Office Action, page 7).

The recitation in claim 5 of “forms providing data values for the entry of foundational data associated with said data values” would not have been obvious to one of ordinary skill in the art. Indeed, the Examiner cited no prior art reference teaching or even suggesting that it would have been obvious to use electronic forms over the claimed asset tracking network to collect foundational data related to monitoring assets. Moreover, the fact that (1) other devices such as local controllers are used to acquire asset related information, and (2) a separate analysis controller is used to analyze data from many different sources, plainly render the recited use of forms for the acquisition of foundational data, and the transmission of this data to an analysis controller, to be non-obvious.

The Applicants’ claims incorporate a particular architecture and structure of devices in the management of asset data. It is contrary to the holding of the Federal Circuit Court of Appeals in In re Thrift, Case Number 01-1445 (Fed. Cir. August 9, 2002) and in In re Sang Su Lee, 2002 U.S. App. LEXIS 855, at *17-18 (Fed. Cir. January 18, 2002) to reject the Applicants’ based on a high-level generalization that the prior art includes certain distributed processing architectures, and that “forms are a well known processing tool for “presenting and/or receiving data in a structured manner” (Final Office Action, page 7). The prior art does not disclose the particular structural and relational elements included in Applicants’ claims. Thus, in Remarks

filed August 11, 2003 (page 17), Appellants noted that the Examiner's bald assertion of obviousness should be supported with an actual reference of a duly executed affidavit pursuant to MPEP § 2144.03. However, the Examiner has not provided the requested support.

Contrary to the assertions of the Examiner, it would not have been obvious to one of ordinary skill in the art to use a hand held device and forms to have foundational data collected prior to having acquired data collected over an electronic asset tracking system. Therefore, for at least the foregoing reasons, claims 5 and 6 are in condition for allowance.

2. Claim 7: The Office Action fails to point to support in the prior art in relation to the elements of claim 7.

Claim 7 recites that "said hand held receives parts data associated with the asset, said parts data in the form of at least one of inventory, inventory location, and a parts catalog." The Final Office Action fails to point to any disclosure whatsoever in Koether or to any other basis as to why claim 7 is obvious over Koether. Thus, the Final Office Action clearly fails to meet the Examiner's burden required by In re Sang Su Lee, 2002 U.S. App. LEXIS 855, because the rejection of no one element, much less each and every element, of the claim 7 is supported by a prior art citation. Thus, in Remarks filed August 11, 2003 (page 18), Appellants noted that the Examiner's bald assertion of obviousness should be supported with an actual reference of a duly executed affidavit pursuant to MPEP § 2144.03. However, the Examiner has not provided the requested support.

The limitation of receiving parts data through a hand held device in the context of an asset management system using a particular configuration of devices was not specifically addressed by the Examiner. Moreover, the prior art does not disclose the particular structural and relational elements included in the Applicants' claims. For at least these reasons, claim 7 is in condition for allowance.

D. CLAIMS 12-15, 19, AND 20 ARE NOT OBVIOUS OVER KOETHER IN VIEW OF HEAGLE AND MABUCHI.

Claims 12-15, 19, and 20 were rejected under 35 U.S.C. 103(a) as being obvious over Koether in view of Heagle and Mabuchi. However, as explained below, the cited references as combined would not have rendered each and every element of the claimed invention obvious to one skilled in the art. Moreover, the cited references contain no affirmative suggestion to

combine and actually teach away from their combination. Therefore, claims 12-15, 19, and 20 are in condition for allowance.

1. Claims 12 and 20: The cited references do not teach “an analysis of user training or user certification with respect to a class of assets.”

Claim 12 recites that “said access authorization includes an analysis of user training or user certification with respect to a class of assets including the asset.” Claim 20 recites that “said additional user data includes at least one of a user training and a user certification with respect to a class of assets including the asset.”

The Examiner correctly admits on page 8 of the Final Office Action that Koether does not teach user training. However, the Examiner’s assertion that Heagle teaches “an analysis of user training or user certification with respect to a class of assets” is incorrect. Heagle teaches that food service employees wear identification badges that interact with a system for monitoring and controlling food service requirements related to safety and performance compliance (Heagle, col. 6, lines 38-62; col. 9, lines 23-26). Heagle’s teachings related to training are limited to a network providing training to human employees regarding responsibilities to preserve a safe and efficient food service environment (Heagle, col. 16, lines 30-39). For example, Heagle teaches that an alert will activate when its system detects a violation of sanitary conditions at a certain facility location (e.g. an employee fails to wash his hands after using a bathroom facility). Heagle does not teach of “user training or user certification with respect to a class of assets” (claims 12 and 20).

Therefore, for at least the foregoing reasons, claim 12, and claims 13-14 dependent on claim 12, are in condition for allowance, as is claim 20.

2. Claims 13 and 15: The cited references do not teach an “authorization subsystem including an asset access mechanism to receive said user identification from a data transmission point associated with the asset”.

Claim 13 recites “an authorization subsystem, said authorization subsystem including an asset access mechanism to receive a user identification from a data transmission point associated with the asset and a comparison of said user identification from said data transmission point with said user identification from a remote database to confirm the identify of said user.” Similarly, claim 15 recites that “said user identification is compared to access authorization to confirm proper authentication, said asset access mechanism permitting operation of the asset upon proper

authentication.” However, the Final Office Action fails to make any citation to an authorization subsystem that includes an asset access mechanism. In addition, the Examiner admits on page 8 of the Final Office Action that neither Koether nor Heagle recites a function of receiving a “user identification from a data transmission point associated with the asset” as required by claim 13.

Mabuchi also fails to teach all the elements of claim 13. Mabuchi’s teachings of user identification do not disclose receiving a “user identification from a data transmission point associated with the asset” (claim 13). Mabuchi’s user identifications are used to monitor and control entry to and exit from certain locations, particularly dangerous locations of an industrial plant such as where high voltage power creates a dangerous condition (Figure 26; col. 33, lines 14-39). Thus, Mabuchi titles his disclosure, “MAINTENANCE/INSPECTION SUPPORT APPARATUS AND ENTRY/EXIT MANAGEMENT APPARATUS.” The “user identification” citations referenced in the Final Office Action relate to Mabuchi’s entry/exit management apparatus rather than Mabuchi’s maintenance/inspection support apparatus. Therefore, Mabuchi does not disclose receiving a “user identification from a data transmission point associated with the asset” (claim 13). Mabuchi’s user identification functions in relation to locations rather than in relation an asset. Mabuchi also fails to teach an “asset mechanism permitting operation of the asset upon proper authentication” (claim 15).

Therefore, for at least the foregoing reasons, claims 13 and 15 are in condition for allowance. Claim 14 depends from claim 13 and is therefore in condition for allowance for at least this reason.

3. Claims 13 and 19: The cited references fail to teach a comparison of user identification.

With regards to claim 13, neither Koether, Heagle, nor Mabuchi teach a “comparison of said user identification from said data transmission point with said user identification from a remote database to confirm the identity of said user” (claim 13). With regards to claim 19, neither Koether, Heagle, not Mabuchi teach a “user identification being compared with a corresponding user identification stored in said asset controller, and providing selective access authorization based on additional user data stored in said asset controller for said user identification.” Moreover, the cited references would not have made the claimed elements obvious to one of ordinary skill.

Therefore, for at least the foregoing reasons, claims 13 and 19 are in condition for allowance.

4. Claims 12-15, 19, and 20: The cited references do not affirmatively suggest their combination and teach away from such combination.

The Examiner fails to state a *prima facie* case of obviousness by failing to provide any motivation for the combination of Koether, Heagle, and Mabuchi. (See Final Office Action, page 9.) Moreover, there is simply no affirmative suggestion or motivation in the art to combine Mabuchi with Heagle or Koether. Such a combination is particularly inappropriate when the food service environment of Koether and Heagle is contrasted with the industrial plant operations of Mabuchi. Even if there were some motivation to combine Mabuchi with Heagle or Koether, there is clearly no affirmative motivation or hint to do so outside of food service environment. Heagle teaches away from combination with Mabuchi: “The principal motive for this interactive network is to maintain control of the food processing methods and employee involvement in this process ensuring compliance with the latest HACCP (Hazard Analysis of Critical Control Points) and the Federal Government’s Model Food Code Guidelines” (Heagle, col. 8, lines 44-49). In contrast, Mabuchi’s monitoring of industrial plants for safety purposes has nothing to do with food processing. Most importantly, none of the three cited references focus on the functionality of managing assets. The vastly different goals and perspectives of the three cited references teach away from each other, and the Applicants’ claims.

Therefore, at least because Koether, Heagle, and Mabuchi are incapable of combination, claims 12-15, 19, and 20 are in condition for allowance.

IX. CONCLUSION


Appellants respectfully submit that all of the appealed claims in this application (claims 1-25) are patentable for at least the reasons stated above and request that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims. The references cited by the Examiner against the Appellant’s claims fail to disclose several material elements of the Appellant’s claims. Only one novel and non-obvious element is required for patentability. In summary, the rejection of Appellant’s claims was not proper because the Examiner failed to: (i) disclose all of the claim elements in prior art; and (ii) provide

evidence supporting the assertion that a suggestion or motivation existed in the art to combine or modify the references as asserted by the Examiner.

This brief is submitted in triplicate. It is believed that any fees due with respect to this paper have been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

Date: July 1, 2004

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APPENDIX OF CLAIMS ON APPEAL – CLAIMS 1-25

1. A system for gathering and analyzing data relating to a non-fixed movable asset comprising:

a local controller located at a first location for acquiring data that is representative of at least one operating characteristic of the asset;

an analysis controller located at a second location that is responsive to said acquired data from said local controller, wherein said analysis controller provides for generating a preventative maintenance determination from said acquired data and at least one historical characteristic relating to said asset;

an electronic communications network connected between said local controller and said analysis controller, said electronic communications network permitting transmission of said acquired data from said local controller to said analysis controller;

a hand held device receiving at least a sub-set of said acquired data stored in said analysis controller; and

wherein said hand held device is not said local controller.

2. A system as recited in claim 1, wherein said hand held device is in direct contact with said analysis controller.

3. A system as recited in claim 1, wherein a second computer system is disposed between said analysis controller and said hand held device.

4. A system as recited in claim 3, wherein said second computer system receives said acquired data, selectively modifies aspects of said acquired data, and forwards said acquired data including said modified aspects, to said hand held device.

5. A system as recited in claim 1, wherein said hand held includes forms, said forms providing data values for the entry of foundational data associated with said data values, said data values and said foundational data being transmitted to said analysis controller.

6. A system as recited in claim 5, wherein said foundational data is collected prior to said acquired data.

7. A system as recited in claim 1, wherein said hand held receives parts data associated with the asset, said parts data in the form of at least one of inventory, inventory location, and a parts catalog.

8. A system as recited in claim 1, wherein said analysis controller includes a database, said database including data values, collected data and comparison data being available for a selected data value.

9. A system as recited in claim 8, wherein said comparison data represents one of a best practice level and past historical data to provide a base point for comparison with said collected data.

10. A system as recited in claim 8, wherein said collected data includes at least user data representing a user accessing the asset.

11. A system as recited in claim 10, wherein said user data includes at least a sub-set of user identification, and access authorization.

12. A system as recited in claim 11, wherein said access authorization includes an analysis of user training or user certification with respect to a class of assets including the asset.

13. A system as recited in claim 10, wherein said system includes an authorization subsystem, said authorization subsystem including an asset access mechanism to receive a user identification from a data transmission point associated with the asset and a comparison of said user identification from said data transmission point with said user identification from a remote database to confirm the identify of said user.

14. A system as recited in claim 12, wherein said remote database is one of said local controller and said analysis controller.

15. A system as recited in claim 12, wherein said user identification is compared to access authorization to confirm proper authentication, said asset access mechanism permitting operation of the asset upon proper authentication.

16. A system for gathering and analyzing data relating to a non-fixed movable asset comprising:

a local controller located at a first location for acquiring data that is representative of at least one operating characteristic of the asset;

an analysis controller located at a second location that is responsive to said acquired data from said local controller for generating an analysis of said acquired data, said analysis including a determination of a preventative maintenance schedule from a collected maintenance history characteristic related to the asset;

an electronic communications network connected between said local controller and said analysis controller and permitting transmission of said acquired data from said local controller to said analysis controller, said analysis controller including a database, said database including data values, collected data and comparison data being available for a selected data value;

a hand held device including a form, said form providing at least a subset of said data values for the entry of foundational data, said foundational data being transmitted to said analysis controller and stored in said database; and

wherein said local controller is not said hand held device.

17. A system as recited in claim 16, wherein said comparison data represents one of a best practice level and past historical data to provide a base point for comparison with said collected data.

18. A system for gathering and analyzing data relating to a non-fixed movable asset comprising:

an asset access device;

a local controller located at a first location for acquiring data received from said asset access device that is representative of a request for user authentication;

an analysis controller located at a second location that is responsive to said user authentication to generate an analysis of said request, said analysis including a preventative maintenance schedule generated from a collected maintenance history characteristic related to the asset and the acquired data;

an electronic communications network connected between said local controller and said analysis controller and permitting transmission of said request from said local controller to said analysis controller; and

wherein said asset access device is not said local controller.

19. A system as recited in claim 18, further including an authorization subsystem and an asset controller, said asset access device receiving a user identification, said user identification being compared with a corresponding user identification stored in said asset controller, and providing selective access authorization based on additional user data stored in said asset controller for said user identification.

20. A system as recited in claim 18, wherein said additional user data includes at least one of a user training and a user certification with respect to a class of assets including the asset.

21. The system of claim 1, further comprising a second local controller located at a third location for acquiring data that is representative of at least one operating characteristic of a remote asset.

22. The system of claim 21, wherein said analysis controller provides for generating said preventative maintenance determination from the acquired data originating from said second local controller.

23. The system of claim 22, wherein said analysis controller provides for generating said preventative maintenance determination from at least one remote historical characteristic relating to said remote asset.

24. The system of claim 23, further comprising an asset category, wherein said asset and said remote asset belong to the same said asset category.

25. The system of claim 24, wherein said historical characteristic and said remote historical characteristic are not dates on which maintenance were performed.